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**UNITED STATES DEPARTMENT OF COMMERCE**

**United States Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/733,554 12/04/00 KLINTZ

R 47953DIV

HM12/0330

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EXAMINER

LILH	
ART UNIT	PAPER NUMBER

1624  
DATE MAILED:

3  
03/30/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/733,554**

Applicant(s)  
**Kilintz et al.**

Examiner  
**Hong Liu**

Group Art Unit  
**1624**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-43 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-43 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### **DETAILED ACTION**

Claims 1-7, 12-18, 20-43 are pending in this application.

#### ***Specification***

Applicant is reminded of the proper content of an Abstract of the Disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, *e.g.*, "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

Complete revision of the content of the abstract is required on a separate sheet. The abstract should be no more than 150 words on one page.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The following reason(s) apply:

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The claims are not commensurate in scope as to the possibilities for the “enol ether”, “enol form” of the compound, and “heterocyclic structure” for the R variables. The specification has no definitions for these terms and, therefore, they are open-ended and all encompassing.

The nature of the invention in the instant application has claims which embrace a diversity of chemically and physically distinct compounds, wherein R15 and R16 together with the common nitrogen atom form a saturated or unsaturated 4-membered to 7-membered heterocyclic structure, etc. While a few compounds are disclosed, there is insufficient guidance for preparing additional herbicides which would be effective since the cited examples are drawn to a homogenous group of compounds not remotely commensurate in scope to applicants' claims. Only compounds wherein R1 is chlorine, W is  $-C(R8)=R(9)-CN$  and  $-C(R8)=C(R9)-CO-R10$  have been made.

Furthermore, little testing data is provided for any of the compounds listed in the specification. Examples should be of sufficient scope as to justify the scope of the claim. However, the generic claims are much broader in scope than is represented by the testing. The definitions of the various R variables on the phenyluracil ring system embrace many structurally divergent groups not represented at all in testing, since testing for the instant compounds is not seen in the specification. Markush claims must be provided with support in the disclosure when the “working examples” fail to include written description(s) which teach how to make and use Markush members embraced thereby in full, clear and exact terms. See *In re Fouch*, 169 USPQ 429.

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This area of activity can be expected to be highly structure specific and unpredictable, as is generally true for chemically-based pharmacological activity. In view of the structural divergence in the claims, one skilled in the art could not reasonably extrapolate the activities of some of the claimed compounds to the other structurally divergent compounds embraced by the claims which have not been tested. In cases directed to chemical compounds which are being used for their physiological activity, the scope of the claims must have a reasonable correlation to the scope of enablement provided by the specification. See *In re Surrey* 151 USPQ 724 regarding sufficiency of disclosure for a Markush group. No reasonable assurance has been made that the instant compounds as an entire class have the required activities needed to practice the invention. Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability" have been demonstrated to be sufficiently lacking in the instant case for the scope being claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

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2. 1). Claim 2 recites the limitation " $X^2R^3$ ". There is insufficient antecedent basis for this limitation in the claim.
3. 2). Claim 14 is a substantial duplicate of Claim 12, as the only difference is intended use which is not given material weight. Note In re Tuominen 213 USPQ 89.
4. 3). "3-phenyluracil" in claims 1 and 43 implies more than what is positively recited. "compound" is suggested.
- 4). Claims 2 and 26-35 recite the limitation "enol ether". There is insufficient antecedent basis for this limitation in the claim.
- 5). Claim 38 is a substantial duplicate of Claim 36, as the only difference is intended use which is not given material weight. Note In re Tuominen 213 USPQ 89.
- 6). In claim 1, three lines from the bottom of page 3 of the preliminary amendment, there appears to be a misspelling of "C3-C, cycloalkyl."
5. 7). The use of "heterocyclic structure" in the definition of R15 and R16 is unclear to the array of heteroatoms, size of the rings, as well as nature of atoms as ring members. See In re Wiggins 179 USPQ 421 for certain terminology regarding heterocyclic ring systems.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for **official** business is (703) 308-4556. Any inquiry of a general nature or relating to the status of

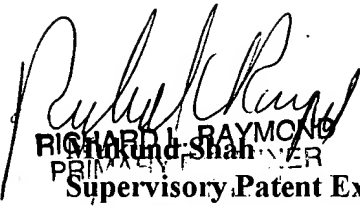
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this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

hl  
March 28, 2001

  
**RICHARD L. RAYMOND**  
**Supervisory Patent Examiner**  
**Art Unit 1624**